

RESPONSE TO FINAL OFFICE ACTION (2)

APPLICANT: Akira Osawa; SERIAL NO.: 09/293,509; AU: 3714

FILED: April 15, 1999; EXAMINER: White, C.; ATT'Y. DKT.: RM.HPN

R E M A R K S

Amendments are presented herein to improve the form of the subject application and in response to the Examiner's comments in the above-identified Office Action.

Continued Prosecution Application (CPA)

Applicant gratefully acknowledges that the request filed on October 7, 2002 for a Continued Prosecution Application (CPA) under 37 C.F.R. §1.53(d) based on parent Application No. 09/293,509 is acceptable to the Examiner, and that a CPA has been established. The following is a response to the action on the CPA.

Finality of the Office Action

The Examiner states that this is a CPA of Applicant's earlier Application No. 09/293,509, and that all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, this action is made final by the Examiner even though it is a first action in this case. The Examiner directs Applicant's attention to MPEP §706.07(b).

Abstract

The Examiner states that Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract, according to the Examiner, should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. The Examiner continues by stating that it is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding

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whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," *etc.*

Applicant has amended the Abstract of the Disclosure so that the amended Abstract is significantly shorter than 150 words. Additionally, legal phraseology has been deleted. Accordingly, it is respectfully asserted that the Examiner's objection to the Abstract has been overcome.

Double Patenting

The Double Patenting Rejection set forth in the previous office action (Paper #14) is hereby repeated and incorporated by reference. As previously noted, this rejection can be overcome by a timely filed terminal disclaimer. The examiner further notes that until the terminal disclaimer is actually filed, the rejection will stand.

Applicant states once again that he intends to file a terminal disclaimer at such time as allowable subject matter is indicated by the Examiner.

Claim Rejections - 35 U.S.C. § 103(a)

CLAIMS 1-12 AND 14

Claims 1-12 and 14 stand rejected under 35 U.S.C. § 103(a) as specifying subject matter considered by the Examiner to be obvious over United States Patent No. 5,393,057 ("Marnell II") in view of the Farrell reference (GB 2242300A).

Regarding claims 1-12 and 14, the Examiner states that the Marnell II or Farrell references teach a gaming machine for use by a player the gaming machine comprising: a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of

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predetermined display states; a controller coupled to said variable display for causing said variable display to display the graphical information; and a secondary display having a display area for displaying a plural number of symbol images, the symbol images being associated with one of the plurality of predetermined display states displayed as a result of the principal game, the number of the symbol images displayed in the display area being increased each time that the principal game results in one of the predetermined states, thereby advancing the game (Farrell-abstract and Fig. 1; Marnell- abstract and Fig. 1). The Examiner grants that the references are silent on the symbol images being of a single kind. However, the Examiner believes that the gaming machines are functionally operable to have the symbol images being of a single kind, and that this is merely a matter of changing the software for the specific kind of secondary game that is desired. Therefore, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate this feature in the Marnell II or Farrell references to simplify the game and make it easier for the players to learn. The Examiner directs Applicant's attention to the previous Office Action, Paper #11 for citations to the sections in the Marnell II or Farrell references that teach the feature of the dependent claims, which, according to the Examiner, Applicant has amended for further clarity, but the features are similar and taught by the prior art of record.

CLAIM 13

Claim 13 stands rejected under 35 U.S.C. 103(a) as specifying subject matter considered by the Examiner to be obvious over Marnell II (5,393,057) or Farrell (GB 2242300A) in view of United States Patent No. 6,004,207 ("Wilson, Jr. *et al.*") or United States Patent No. 5,848,932 ("Adams").

Regarding claim 13, the Examiner states that the Marnell II or Farrell references disclose all the limitations of the claim as discussed above. The Examiner concedes, however, that the Marnell II or Farrell references fail to disclose a multiplied payout. The Examiner continues by stating that

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in an analogous gaming machine, the Wilson or Adams references disclose the multiplication of a payout value (Wilson- abstract; Adams- abstract). According to the Examiner, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in the systems disclosed in the Marnell II or Farrell references in order to provide multiplied payouts in slot machines to increase players' interests and financial reward in the game.

APPLICANT'S RESPONSE

Applicant respectfully asserts that independent claim 1, which is the only independent claim in the case, specifies subject matter that is not taught or suggested by any combination of the Marnell II, Farrell, Wilson, Jr. *et al.*, and Adams references. More specifically, independent claim 1 specifies:

a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states;

a controller coupled to said variable display for causing said variable display to display the graphical information; and

a secondary display having a plurality of display areas for displaying a number of a single kind of symbol images, the single kind of symbol images corresponding to one of the plurality of predetermined display states displayed as a result of the principal game, the number of the single kind of symbol images displayed in each of the display areas being increased each time that the principal game results in the one of the predetermined display states, thereby advancing a secondary game.

Amended claim 1 specifies a secondary display (6a) having a plurality of secondary display areas (for example, three display areas 6a1 to 6a3 as shown in Fig. 3) for displaying one or more of a single kind of symbol images (*e.g.*, "7," "3BAR," or "2BAR"), the single kind of symbol images corresponding to one of the plurality of predetermined display states displayed as a result of the principal game, the number of the single kind of symbol images ("7," "3BAR," or "2BAR") displayed in each of the display areas (6a1 to 6a3) being increased each time that the principal game results in the one of the predetermined display states.

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In accordance with the foregoing, it is possible for a player to comprehend the number or frequency of the appearances of each display state displayed in the principal game as compared with each of the plural secondary display areas. This is useful in enabling the player to predict the appearance of each display state in the principal game, and accordingly enables the player to predict a result of the principal game.

The Marnell II reference teaches a secondary display having a bingo matrix (#51) that corresponds to the display area for displaying plural kinds of images necessary for a secondary game. However, the Marnell II reference does not disclose or suggest a plurality of secondary display areas for displaying a number of a single kind of symbol images ("7," "3BAR," or "2BAR"), the single kind of symbol images corresponding to one of the plurality of predetermined display states displayed as a result of the principal game. Thus, the Marnell II reference does not teach or suggest that the number of the single kind of symbol images displayed in each of the plural display areas is increased each time that the principal game results in the one of the predetermined display states.

The Farrell reference teaches, as shown in Fig. 2 thereof, a secondary display having a second reel display (#22) and a matrix display (#23). However, this reference does not teach or suggest that each secondary display area is associated with one kind of images (#28' or #29') or that each of the plural display areas displays the number of the single kind of symbol images that correspond to one of the plurality of predetermined display states displayed as a result of the principal game.

The Marnell II or Farrell references do not teach the above-enumerated features of the claimed invention. Accordingly, the amended claims specify subject matter that is not taught or suggested by any combination of the Marnell II and Farrell references.

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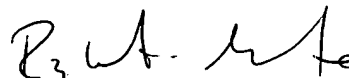
With respect to claim 13, it is noted that this is a dependent claim based on independent claim 1. Accordingly, the subject matter of claim 13 includes all of the above features that, as noted, are not disclosed or suggested in the Marnell II or Farrell references, or in the secondarily applied Wilson or Adams references. Therefore, even though the Wilson and Adams references are asserted by the Examiner as disclosing the multiplied payouts in slot machines, these references do not teach anything that would render the arguments set forth hereinabove in support of the patentability of independent claim 1 not to be persuasive.

Claims 2 and 5-14 all depend from amended independent claim 1, and therefore contain all of the limitations therein. Accordingly, these claims are believed to be in allowable condition for the reasons set forth herein in regard of independent claim 1. Accordingly, it is respectfully asserted that the Examiner's rejection of claims 1, 2, and 5-14 under 35 U.S.C. § 103(a) has been overcome.

Conclusion

In view of the foregoing, it is respectfully requested that the Examiner reconsider the present application, allow the claims, and pass the application for issue. If the Examiner believes that the prosecution of this case can be expedited by a telephone interview, the Examiner is requested to call attorney for Applicant at the telephone number indicated hereinbelow.

Respectfully submitted,



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Annexure 1 - Claim(s) Rewritten to Show Amendments

1. (Four Times Amended) A gaming machine for use by a player, the gaming machine comprising:

a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states;

a controller coupled to said variable display for causing said variable display to display the graphical information; and

a secondary display having a plurality of display [area] areas for displaying a [plural] number of a single kind of symbol images, the single kind of symbol images corresponding to [being associated with] one of the plurality of predetermined display states displayed as a result of the principal game, the number of the single kind of symbol images displayed in each of the display [area] areas being increased each time that the principal game results in the one of the predetermined display states, thereby advancing a secondary game.

2. (Twice Amended) The gaming machine of claim 1, wherein the secondary game is completed when any one of said display [area] areas is filled with the plural number of the single kind of symbol images.

6. (Twice Amended) The gaming machine of claim [3] 1, wherein [said display and further display areas] predetermined values are allotted to said display areas, respectively [respective values].

7. (Twice Amended) The gaming machine of claim 6, wherein the award given to the player is responsive to the particular symbol images displayed as filling the respectively associated one of said [display and further] display areas.

10. (Amended) The gaming machine of claim 9, wherein [a] the display area that is filled with symbol images is cleared to a blank condition in response to the execution of the reset operation.

11. (Twice Amended) The gaming machine of claim 9, wherein [said display and further] the plurality of display areas [are] is cleared to a blank condition in response to the execution of the reset operation.

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12. (Twice Amended) The gaming machine of claim 9, wherein said controller is arranged to perform a selection between a first reset operation for clearing only the display area [to a blank condition only a one of said display and further display areas] filled with symbol images to a blank condition and a second reset operation for clearing [to a blank condition] all of said display areas to a blank condition.

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Annexure 2 - Abstract Rewritten to Show Amendments

A gaming machine [for use by a player is provided with] has a variable display for displaying graphical information corresponding to [at least one of] a[plurality of] graphical element of [elements necessary for] a principal game; a controller coupled to [said] the variable display for causing [said] the variable display to display the graphical information; and a secondary display for displaying an image. The image [displayed by] of the secondary display is used [for playing] in a secondary game that is different from the principal game, [the secondary display displaying an image when the playing of the principal game results in] and is responsive to one of a plurality of predetermined principal game playing states. [The secondary display indicates an image necessary for playing a secondary game when the playing of the principal game results in one of a plurality of predetermined principal game playing states.] A player can [Consequently, a player can have a chance to] win the secondary game [in addition to] and the principal game [that is played] in the variable display. The [In addition, the] images [indicated] in the secondary display constitute a history of the predetermined states that have been presented in the variable display during [play of] the principal game.